

Notice of Allowability

Application No.

10/763,031

Examiner

Marc S. Zimmer

Applicant(s)

BRANDT ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the interview of November 30, 2005.
2. ☒ The allowed claim(s) is/are 1-11 and 13-21.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Howard Lee on November 30, 2005.

The application has been amended as follows:

Please replace the first line of original claim 1 with,

-- A method for dispersing a pigment in a medium which [REDACTED]--.

Also in claim 1, please replace the word "obtainable" in line 2 with

-- obtained --.

In claims 17, 18, and 20, please replace the description of component (b) with,

-- (b) one or more hydroxyl-containing polyesters derived from at least one hydroxycarboxylic acid and/or the corresponding lactone, and at least one diol, --.

Also in claims 17, 18, and 20, please replace the word "obtainable" with

-- obtained --.

Please cancel claim 12.

Applicant had contacted the Examiner to ascertain whether the insertion of the limitation of claim 12 into claim 1 and the limitation of claim 7 into claims 17, 18, and 20 would render the claims allowable. The Examiner made the determination that Applicant's proposal would successfully invalidate *Koerner* as a reference. Both parties agreed that the Examiner would, as a means of expediting prosecution, enter the amendment into the record. The Applicant further requested that the Examiner emphasize that they reserve the right to file a continuation or divisional application to further pursue the subject matter of the cancelled claims. Applicant was advised that the word "obtainable" was indefinite insofar as it connoted that there were other ways of preparing the silicone resin that were not revealed in the claims. Therefore, it would be necessary to replace "obtainable" with "obtained".

The manner in which the Examiner had constructed the rejection over the method claims in view of *Koerner* was such that the pigment was said to represent the dispersing medium. Applicant has now requested that the claims be amended to require that it is a pigment that is being dispersed in a medium. Insofar as the pigment cannot be said to correspond to both the solid to be dispersed and the dispersing medium, Applicant's amendment overcomes the prior art rejection over claim 1 and the claims dependent therefrom.

Concerning claims 17, 18, and 20, the invention described in these claims is now one wherein the polyester is prepared by a specified approach. The compound said

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earlier to correspond to the polyester of the instant invention no longer anticipated this aspect of the invention because it is clear that it could not have been prepared from the materials now stipulated by these claims.

The most relevant art continues to be that which was cited in the correspondence dated June 3, 2005. Insofar as all of these documents fail to even render obvious the prior art, claims 1-11 and 13-21 are deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 09, 2005

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